REMARKS

This Application has been carefully reviewed in light of the Office Action dated July 11, 2007 (*"Office Action"*). At the time of the *Office Action*, Claims 1-44 were pending. The Examiner rejects Claims 1-15, 17-31, and 33-44, and objects to Claims 16 and 32. Applicants appreciate the Examiner's indication that Claims 16 and 32 would be allowable if rewritten in independent form. *See Office Action*, p. 34.

Applicants amend FIGURE 1, a portion of the Specification, and Claims 10, 16, 26, and 32-43. Additionally, Applicants amend Claims 3, 19, and 35 to correct typographical errors. Applicants respectfully request reconsideration and favorable action in this case.

I.   Drawing Objection

The Examiner objects to the drawings because there is lack of descriptive text legends for FIGURE 1. *Office Action*, p. 2 (stating "e.g. '12' should be labeled as 'Analysis Device 12', '18' should be labeled as 'Server 18', '16' should be labeled as 'Router 16'").

Applicants have revised FIGURE 1 in accordance with the Examiner's suggestions. Replacement sheets showing FIGURE 1, as amended, are attached. Applicants respectfully request that the objection to the drawings be withdrawn.

II.   Specification Objection

The Examiner objects to the disclosure because the Specification (on page 5, line 1) recites "Detailed Description of the Drawings" rather "Detailed Description of the Invention." *Office Action*, p. 3. The Examiner asserts that the latter phrase is required by M.P.E.P. § 608.01(g) and 37 C.F.R. 1.71. *Id.*

Without addressing the merits of this objection, Applicants amend the Specification in accordance with the Examiner's suggestion. (This amendment is shown on page 2, *supra*.) Therefore, Applicants respectfully request the objection to the specification be withdrawn.

III.   Claim Objections

A.   Claims 10, 26, and 42:

The Examiner objects to Claims 10, 26, and 42 because these claims include the phrase "an internet control message protocol (ICMP) echo/reply message," which is allegedly

unclear. *Office Action*, p. 3. Without addressing the merits of this objection, Applicants amended Claims 10, 26, and 42 to clarify this claim phrase. Accordingly, Applicants respectfully request that the objections to these claims be withdrawn.

B.   Claims 16, 32, and 43:

The Examiner objects to Claims 16, 32, and 43 as having various antecedent basis issues. *Office Action*, pp. 3-4. Applicants have amended Claims 16, 32, and 43 in accordance with the Examiner's suggestions. Accordingly, Applicants respectfully request that the objections to these claims be withdrawn.

C.   Claims 17-25 and 27-32:

The Examiner objects to Claims 17-25 and 27-32 for containing the allegedly optional language "operable to." *Office Action*, p. 4. Applicants respectfully traverse this objection and submit that "operable to" is not language that makes optional "the steps/functions[] which follow[] 'operable to,'" as asserted by the *Office Action*. *Id*.

First, Applicants respectfully note that the *Office Action* fails to provide any support for the assertion that "operable to" is "optional language." *See id*.

Second, Applicants respectfully submit that the use of "operable to" <u>requires</u> a claimed aspect to actually be operable to perform the later recited functions and/or steps. Claim 17, for example, recites, "a controller operable to determine forward path performance characteristics ... ." Rather than these aspects being optional, Claim 17 clearly requires a controller that is actually operable to "determine forward path performance characteristics ... ." This is confirmed by the Board of Patent Appeals and Interferences. *See Ex parte Ciarla*, Appeal No. 2000-2128, 2002 WL 1801096 (Bd. Pat. App & Interf.) ("The [operable] language which the examiner characterizes as 'merely intended uses' constitutes recitations of the functions of two means-plus-function elements ... ; it therefore cannot be minimized or ignored, but rather, in order to anticipate the claim, [the cited reference] must disclose structure capable of performing those functions.")

Accordingly, Applicants respectfully submit that the claim language "operable to" is not language that makes optional "the steps/functions[] which follow[] 'operable to,'" as asserted by the *Office Action*. Thus, Applicants respectfully request reconsideration and withdrawal of the objections to Claims 17 and 32 and their respective dependent claims.

IV.   Rejection Under 35 U.S.C. § 101

The Examiner rejects Claims 33-43 under 35 U.S.C. § 101, asserting the claims are directed to non-statutory subject matter. *Office Action*, p. 4. During an interview conducted on October 9, 2007 with Juliet Mitchell Dirba (an Attorney for Applicants), the Examiner indicated that the claims, as amended, would comply with the requirements of 35 U.S.C. § 101. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 33-43.

V.   Rejection Under 35 U.S.C. § 102

The Examiner rejects Claims 1, 4, 7, 11, 17, 20, 23, 27, 33, and 36 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,965,572 issued to Boodaghians ("*Boodaghians*"). Applicants respectfully traverse this rejection and submit that *Boodaghians* does not describe, expressly or inherently, each and every limitation of the claims.

Consider Applicants' independent Claim 1, which recites:

A method for detecting network misconfigurations comprising:
identifying a remote target;
transmitting a forward packet series on a data path to the remote target;
receiving at least some packets from a reverse packet series transmitted
on the data path from the remote target;
determining forward path performance characteristics for transmission
of the forward packet series;
determining reverse path performance characteristics for transmission
of the reverse packet series; and
if the forward path performance characteristics and the reverse path
performance characteristics indicate asymmetry on the data path, generating
an alert signaling a potential network misconfiguration of the data path.

Applicants respectfully submit that *Boodaghians* fails to teach every element of this claim.

Among other aspects, *Boodaghians* fails to disclose: (1) "determining forward path performance characteristics for transmission of the forward packet series," (2) "determining reverse path performance characteristics for transmission of the reverse packet series," and (3) "if the forward path performance characteristics and the reverse path performance characteristics indicate asymmetry on the data path, generating an alert ... ," as required by Claim 1. As teaching these claimed aspects, the *Office Action* points to various portions of

Boodaghians and Figure 7 (steps 202 and 205), Figure 8 (steps 302 and 304), and Figure 9 (steps 503 and 504). *Office Action*, p. 8.

Boodaghians teaches that a pre-service or in-service loopback function may be used to test the parameters (*e.g.*, connectivity, delay and other quality of service parameters) of a bi-directional traffic trunk (BTT). *Boodaghians*, col. 7, ll. 21-37. The described BTT includes two unidirectional traffic trunks, one corresponding to each direction. *Id.* at col. 2, ll. 38-54. Figure 7 shows the pre-service loopback function, which may be used before loading the BTT with user traffic in order to "determine[] whether at least one parameter of BTT 10 ... is equivalent to or exceeds ... predetermined standards." *Id.* at col. 8, ll. 4-29. Figure 8 shows an in-service loopback function that allows LER A to "evaluate[] at least one parameter of BTT 10." *Id.* at col. 9, ll. 26-55.

However, *Boodaghians*' determination and analysis of the <u>parameters of a BTT</u> (bi-directional traffic trunk) simply fails to teach, or even suggest, determining both "forward path performance characteristics" and "reverse path performance characteristics." Even assuming, for the sake of argument, that *Boodaghians* teaches determining "performance characteristics" for a loop that includes both the forward and reverse paths, *Boodaghians* still fails to teach (or even suggest) determining <u>forward path performance characteristics</u> for transmission of the forward packet series, as Claim 1 requires. Likewise, *Boodaghians* fails to teach determining <u>reverse path performance characteristics</u> for transmission of the reverse packet series, as is also required by the claim.

Moreover, *Boodaghians*' determination and analysis of the parameters of a BTT fails to teach or suggest anything "indicating **asymmetry** on the data path," much less the aspects specifically required by Claim 1 -- namely, "if the forward path performance characteristics and the reverse path performance characteristics <u>indicate asymmetry on the data path</u>, generating an alert ... ." *Boodaghians* simply fails to teach these claimed aspects.

Thus, *Boodaghians* does not describe, expressly or inherently, each and every element required by Claim 1. Independent Claims 17 and 33 include limitations that, for substantially similar reasons, are not taught by *Boodaghians*. Because *Boodaghians* does not disclose, expressly or inherently, every element of independent Claims 1, 17, and 33, Applicants respectfully request reconsideration and allowance of Claims 1, 17, and 33 and their respective dependent claims.

VI. Rejection Under 35 U.S.C. § 103

A. Claims 2, 12, 18, 28, 34, and 44:

The Examiner rejects Claims 2, 12, 18, 28, 34, and 44 under 35 U.S.C. § 103(a) as unpatentable over *Boodaghians* in view of U.S. Patent No. 5,477,531 issued to McKee et al. ("*McKee*").

As described above, Applicants have shown that *Boodaghians* fails to disclose all limitations of independent Claims 1, 17, and 33. Accordingly, *Boodaghians* fails to teach or suggest all limitations of Claims 2, 12, 18, 28, and 34 because these dependent claims incorporate the limitations of their respective independent claims. Moreover, independent Claim 44 includes limitations that, for substantially similar reasons, are not taught by *Boodaghians*. *McKee* fails to remedy the deficiencies of *Boodaghians*.

Thus, *Boodaghians* and *McKee*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 2, 12, 18, 28, 34, and 44. Because the references fail to teach all limitations of the claims, Applicants respectfully request reconsideration and allowance of Claims 2, 12, 18, 28, 34, and 44.

B. Claims 3, 5, 19, 21, 35, 37, and 39:

The Examiner rejects Claims 3, 5, 19, 21, 35, 37, and 39 under 35 U.S.C. § 103(a) as unpatentable over *Boodaghians* in view of U.S. Patent No. 6,002,671 issued to Kahkoska et al. ("*Kahkoska*").

As described above, Applicants have shown that *Boodaghians* fails to disclose all limitations of independent Claims 1, 17, and 33. Accordingly, *Boodaghians* fails to teach or suggest all limitations of Claims 3, 5, 19, 21, 35, 37, and 39 because these dependent claims incorporate the limitations of their respective independent claims. *Kahkoska* fails to remedy the deficiencies of *Boodaghians*.

Thus, *Boodaghians* and *Kahkoska*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 3, 5, 19, 21, 35, 37, and 39. Because the references fail to teach all limitations of the claims, Applicants respectfully request reconsideration and allowance of Claims 3, 5, 19, 21, 35, 37, and 39.

C.   Claims 8, 9, 24, 25, 40, and 41:

The Examiner rejects Claims 8, 9, 24, 25, 40, and 41 under 35 U.S.C. § 103(a) as unpatentable over *Boodaghians* in view of U.S. Patent No. 6,741,555 issued to Li et al. ("*Li*").

As described above, Applicants have shown that *Boodaghians* fails to disclose all limitations of independent Claims 1, 17, and 33. Accordingly, *Boodaghians* fails to teach or suggest all limitations of Claims 8, 9, 24, 25, 40, and 41 because these dependent claims incorporate the limitations of their respective independent claims. *Li* fails to remedy the deficiencies of *Boodaghians*.

Thus, *Boodaghians* and *Li*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 8, 9, 24, 25, 40, and 41. Because the references fail to teach all limitations of the claims, Applicants respectfully request reconsideration and allowance of Claims 8, 9, 24, 25, 40, and 41.

D.   Claims 10, 26, and 42:

The Examiner rejects Claims 10, 26, and 42 under 35 U.S.C. § 103(a) as unpatentable over *Boodaghians* in view of U.S. Patent No. 7,012,893 issued to Bahadiroglu ("*Bahadiroglu*").

As described above, Applicants have shown that *Boodaghians* fails to disclose all limitations of independent Claims 1, 17, and 33. Accordingly, *Boodaghians* fails to teach or suggest all limitations of Claims 10, 26, and 42 because these dependent claims incorporate the limitations of their respective independent claims. *Bahadiroglu* fails to remedy the deficiencies of *Boodaghians*.

Thus, *Boodaghians* and *Bahadiroglu*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 10, 26, and 42. Because the references fail to teach all limitations of the claims, Applicants respectfully request reconsideration and allowance of Claims 10, 26, and 42.

E.   Claims 13-15 and 29-31:

The Examiner rejects Claim 13-15 and 29-31 under 35 U.S.C. § 103(a) as unpatentable over *Boodaghians* in view of U.S. Patent Application Publication No. 2001/0056503 issued to Hibbard ("*Hibbard*").

As described above, Applicants have shown that *Boodaghians* fails to disclose all limitations of independent Claims 1, 17, and 33. Accordingly, *Boodaghians* fails to teach or suggest all limitations of Claims 13-15 and 29-31 because these dependent claims incorporate the limitations of their respective independent claims. *Hibbard* fails to remedy the deficiencies of *Boodaghians*.

Thus, *Boodaghians* and *Hibbard*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 13-15 and 29-31. Because the references fail to teach all limitations of the claims, Applicants respectfully request reconsideration and allowance of Claims 13-15 and 29-31.

CONCLUSION

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of this Application. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Although no fees are believed to be currently due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

Kurt M. Pankratz
Reg. No. 46,977
(214) 953-6584

Date: October 11, 2007

Customer Number: **05073**